

PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

19281-000800US

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Date of Deposit: November 2, 2005

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Signature

Sara B. McPeak

Application Number

09/687,157

Filed

October 12, 2000

First Named Inventor

John J. Sie et al.

Art Unit

2191

Examiner

Anil Khatri

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 52,471

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____

Signature

William J. Daley

Typed or printed name

303.571.4000

Telephone number

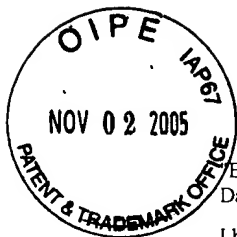
November 2, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 8 pages in this submission.



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Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By: Sara B. McPeak
Sara B. McPeak

PATENT
Docket No.: 19281-000800

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John J. Sie et al.

Application No.: 09/687,157

Filed: October 12, 2000

For: LOCAL STORAGE OF
PROGRAMS

Confirmation No.: 8624

Examiner: Anil Khatri

Art Unit: 2191

PRE-APPEAL BRIEF REQUEST FOR
REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection mailed by the U. S. Patent Office for the above-identified application on August 3, 2005 ("the Final Office Action"). An Advisory Action was mailed on October 21, 2005 indicating that a Response filed on October 3, 2005 under 37 C.F.R. §1.116 ("the Amendment") did not place the application in condition for allowance.

A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

Claims 1, 2, 4-15 and 17-22 stand rejected under 35 U.S.C. §102(e) as being anticipated by the cited portions of U. S. Patent No. 6,167,044 to de Vos et al. (hereinafter "de Vos").

2. Reasons for Requesting Review

Applicant's respectfully submit that the rejection is clearly erroneous since de Vos fails to disclose distributing a program, such as in a Video On-Demand (VOD) or Near Video On-Demand (NVOD) system, that includes commanding an end device, such as a Set-Top Box, to store content before a user specifically requests the program. Rather, de Vos discloses downloading content to an end device only after receiving a selection from a user.

For details of this argument, Applicants refer to the Remarks filed on October 3, 2005 in response to the Final Office Action of August 3, 2005. A portion of these Remarks is restated here for convenience. Under de Vos, "navigation data including a software program for displaying a menu of service items and identification data corresponding to each service item is downloaded preferably beforehand from at least one navigation device selected by the end device." (Col. 5, lines 8-12) "The monitor of end device displays such a menu of the available service items and, if necessary, corresponding identification data thereof." (Col. 5, lines 12-15) "If a user selects a video and/or audio program through the input device from the menu by pointing the desired video program with a pointer in the monitor or by entering the identification data corresponding to the desired program, if displayed on the monitor, the identification data is supplied to the system manager by the end device via ATM switch." (Col. 5, lines 19-24) "The system manager down-loads a VOD-software program for end devices corresponding to a selected video program to the end device, after the system manager

receives identification data from the set top box." (Col. 5, lines 39-42) That is, de Vos teaches providing a menu or program guide to a user for selection and download of VOD or other content. However, de Vos does not disclose commanding the end device to store content before a user specifically requests the program.

The Final Office Action of August 3, 2005 cites col. 3, lines 26-50 and col. 4, lines 20-54 to support the argument that de Vos teaches an end device "involved in storing contents and allow[ing] the user to get the programs before his/her request." Applicant's agree that de Vos teaches an end device involved in storing content but NOT before a user's request. The end device of de Vos stores content only AFTER a selection from the user. Therefore, Applicant's respectfully disagree that the cited portions, or any other portions of de Vos, disclose an end device commanded to store content before it is requested by the user.

Claim 1, upon which claims 2, 4-7, and 21-22 depend, is directed to a method for distributing a program sent by a content distributor to a user location. Claim 14, upon which claims 15 and 17-20 depend, is directed to a distribution program product having code for distributing a program sent by a content distributor to a user location. Both claim 1 and claim 14 recite in part "receiving a command from the content distributor to store the program at the user location before a user specifically requests the program." de Vos does not disclose receiving a command from the content distributor to store the program at the user location before a user specifically requests the program. Rather, de Vos teaches downloading content to an end device only after receiving a selection from a user. For at least these reasons, claims 1-2, 4-7, 14-15, and 17-22 are distinguishable from de Vos and should be allowed.

Claim 8, upon which claims 9-13 depend, is directed to a method for distributing a program sent by a content distributor to a user location and recites in part "commanding the user location to store the program from the content distributor without

a user associated with the user location specifically requesting the program" and "sending the program to the user location for storage before a user specifically requests the program." de Vos does not disclose commanding the user location to store the program from the content distributor without a user associated with the user location specifically requesting the program or sending the program to the user location for storage before a user specifically requests the program. Rather, de Vos teaches downloading content to an end device only after receiving a selection from a user. For at least these reasons, claims 8-13 are distinguishable from de Vos and should be allowed.

Respectfully submitted,



William J. Daley
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: (303) 571-4000
Fax: (303) 571-4321

WJD/sbm